

Appl. No. 10/526297
Reply to Office Action dated September 25, 2009

REMARKS

This Amendment is in response to the final Office Action mailed on September 25, 2009. Claim 3 is amended and is supported, for example, in the specification on page 12, line 22-page 14, line 6 and in Figures 5 and 6. Claim 19 is new and is supported, for example, by claim 3 and in the specification on page 12, line 22-page 14, line 6 and in Figures 5 and 6. No new matter is added. Claims 1, 3 and 5-19 are pending.

Final Office Action:

Applicants assert that the finality of the present Office Action, in response to the Amendment and RCE filed on August 12, 2009 is improper.

First, MPEP §706.07(b) explicitly requires that for a new application to be finally rejected in the first Office action all claims of the new application must be drawn to the same invention claimed in the earlier application.

Applicants note however that all claims of the new application are not drawn to the same invention claimed in the earlier application. Particularly, amendments were made to claims 1 and 13 that changed the claimed invention from the claimed invention examined in the March 13, 2009 Office Action. Accordingly, the finality of the current Office Action was improperly made final as the requirements, as set forth in MPEP §706.07(b), were not met.

Second, Applicants note that the present rejection of claims 1, 3, 5-7, 9, 10, 13, 15 and 16 also disregarded the claimed vertical positional relationships between the water absorbent carrier, the penetration layer and the coloration pads. Particularly, the present rejection disregards the claimed features stating each of the coloration pads "having a lower surface held in contact with the upper surface of the penetration layer", and "having an exposed upper surface facing away from the upper surface of the penetration layer". As discussed in more detail below, these features of claim 1 are not shown in the prior art and were not considered in the present Office Action. Accordingly, this rejection is improper as it fails to show where the cited prior art teaches each and every feature recited in the claims.

For at least these reasons, Applicants note that if a future Office Action is mailed in response to this Amendment, the Office Action should not be made final.

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Amendments to Claim 3 and New Claim 19:

As claim 3 is amended and claim 19 is new, the claims of this new application are not drawn to the same invention claimed in the August 12, 2009 Amendment. Accordingly, Applicants note again that if a future Office Action is mailed in response to this Amendment, the Office Action should not be made final.

§103 Rejections:

Claims 1, 3, 5-7, 9, 10, 13, 15 and 16 have been rejected as unpatentable over Gibson (US Patent No 5,527,509) in view of Ray (US Patent No. 6,258,045). Applicants respectfully traverse the rejection.

Claim 1 requires a test kit having water absorbent carrier, penetration layer and coloration pads. An upper surface of the water absorbent carrier is in contact with a lower surface of the penetration layer. A lower surface of the coloration pads is in contact with an upper surface of the penetration layer. Also, an exposed upper surface of the coloration pads faces away from the upper surface of the penetration layer. Claim 13 is a process for producing a test kit with features tracking the above noted features of claim 1, and the distinctions noted for claim 1 apply to claim 13 as well.

First, Applicants note that the rejection of claim 1 is unclear. The rejection first interprets the reagent zones 16 of Gibson as the penetration layer of claim 1 and the Cyclopore membrane 15 of Gibson as the coloration pads of claim 1 (see page 2 of the Office Action). The rejection then states "wherein a liquid sample is applied to the membrane and allowed to penetrate to the zone ('supplied to the penetration layer is fed to each of the coloration pads through the penetration layer' and wherein the penetration layer is formed with a plurality of thicknesswise extending pores for allowing the sample liquid to penetrate thicknesswise of the penetration layer while preventing the sample liquid from spreading in a planar direction of the penetration layer'").

That is, the rejection first interprets the zones 16 of Gibson as the penetration layer and the membrane 15 of Gibson as the coloration pads, but then later interprets the membrane 15 of Gibson as the penetration layer and the zones 16 of Gibson as the coloration pads. Thus, the rejection not only does not consider all of the features of claim

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1 as discussed above, the rejection does not provide a coherent analysis of how the features that are analyzed in the rejection are shown by the cited prior art.

Second, regardless of the interpretation intended in the rejection, Gibson does not teach the above features of claim 1. If the zones 16 of Gibson are interpreted as the penetration layer and the membrane 15 of Gibson is interpreted as the coloration pads, Gibson does not teach or suggest each of the coloration pads "having a lower surface held in contact with the upper surface of the penetration layer". In contrast, Figure 10 of Gibson shows a gap between the zones 16 and the membrane 15, and not in contact with each other.

Also, under this interpretation, Gibson cannot be combined with Ray to teach a water absorbent carrier that "spreads the sample liquid in the planar direction of the water absorbent carrier for drawing up by the penetration layer", as recited in claim 1. Figure 10 of Gibson shows the lower surface of the zones 16 secured to a backing card 11 by means of an adhesive strip 13, and not to a water absorbent carrier that "spreads the sample liquid in the planar direction of the water absorbent carrier for drawing up by the penetration layer". Column 8, lines 8-23 of Gibson teaches that the liquid sample is applied directly to the membrane 15 and then filtered through to the zones 16.

Thus, even if Ray teaches the water absorption carrier of claim 1, it would not be obvious to modify Gibson based on Ray to obtain the features of claim 1 as it would require replacing the backing card 11 and the adhesive strip 13 of Gibson with a water absorbent carrier. However, this would destroy the intended functionality of Gibson as it would require the liquid sample to be applied directly to the water absorption carrier as opposed to the membrane 15. Thus, it would not be obvious to one skilled in the art to combine the features of Gibson and Ray to obtain the features of claim 1.

Alternatively, if the membrane 15 of Gibson is interpreted as the penetration layer and the zones 16 of Gibson is interpreted as the coloration pads, then Gibson does not teach or suggest "each of the coloration pads having an exposed upper surface facing away from the upper surface of the penetration layer", as recited in claim 1. In contrast, Figure 10 of Gibson teaches that the zones 16 are covered by the membrane 15, and not exposed. Also, Figure 10 of Gibson shows the upper surface of the zones 16 facing

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towards the upper surface of the membrane 15, as opposed to facing away from the upper surface of the membrane 15.

Further, Gibson still does not teach or suggest each of the coloration pads "having a lower surface held in contact with the upper surface of the penetration layer". In contrast, Figure 10 of Gibson shows a gap between the membrane 15 and the zones 16, and not in contact with each other. Moreover, Figure 10 of Gibson shows the lower surface of the zones 16 secured to a backing card 11 by means of an adhesive strip 13, and not held in contact to an upper surface of the membrane 15.

Also, under this interpretation, Gibson cannot be combined with Ray to teach "a penetration layer having a lower surface held in contact with the upper surface of the water absorbent carrier", and a water absorbent carrier that "spreads the sample liquid in the planar direction of the water absorbent carrier for drawing up by the penetration layer", as recited in claim 1. Column 8, lines 8-23 of Gibson teaches that the liquid sample is applied directly to the membrane 15. Even if Ray teaches a water absorption carrier in contact with a penetration layer, it would not be obvious to modify Gibson based on Ray as it would require fitting a water absorbent carrier between the membrane 15 and the zones 16 to meet the features of "a penetration layer having a lower surface held in contact with the upper surface of the water absorbent carrier". However, if Gibson was modified accordingly, other features of claim 1 that recite that the water absorbent carrier "spreads the sample liquid in the planar direction of the water absorbent carrier for drawing up by the penetration layer" would not be met. Moreover, under this configuration, the water absorbent carrier would at best serve no function for the apparatus of Gibson and at worst would prevent the zones 16 from receiving the sample passing through the membrane 15. Thus, it would not be obvious to one skilled in the art to combine the features of Gibson and Ray to obtain the features of claim 1.

Accordingly, under any interpretation, the combination of Gibson and Ray fail to teach or suggest the features of claim 1, and accordingly claim 13. Thus, claims 1 and 13 should be allowed. Claims 3, 5-7, 9, 10 depend from claim 1 and should be allowed for at least the same reasons. Claims 15 and 16 depend from claim 13 and should be allowed for at least the same reasons. Withdrawal of this rejection is requested.

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Also, with respect to claim 3, the combination of Gibson and Ray does not teach or suggest a water absorbent carrier that includes a laminated portion covered by the penetration layer and a non-laminated sample applying portion extending beyond the penetration layer for exposure to apply the liquid sample.

As noted in the rejection, Gibson does not teach a water absorbent carrier. The rejection interprets the application member 114 of Ray as the water absorbent carrier of claim 3. The rejection also notes that Ray teaches a "penetration layer is laminated on a water absorbent carrier that spreads the sample liquid in the planar direction of the water absorbent carrier for drawing up by the penetration layer". However, nowhere does Ray teach or suggest that any portion of the application member 114 is laminated. In contrast, Ray merely teaches that the application member 114 "is fluidly connected to separation member 118 via separation member perforation 115, an aperture through impermeable spacer 117" (see column 17, lines 4-7 of Ray).

Accordingly, the combination of Ray and Gibson cannot teach or suggest a water absorbent carrier that includes a laminated portion covered by the penetration layer and a non-laminated sample applying portion extending beyond the penetration layer for exposure to apply the liquid sample, as required by claim 3.

Claims 11, 12, 17 and 18 have been rejected as obvious over Gibson in view of Ray and further in view of Iwata (US Publication No. 2001/0028862). Applicants respectfully traverse this rejection. Iwata does not remedy the deficiencies of Gibson and Ray, and the rejection should be withdrawn for this reason alone. Applicants do not concede the relevance of Iwata to the features of claims 11, 12, 17 and 18, or the suitability of the references for combination.

Claim 14 has been rejected as obvious over Gibson in view of Ray and further in view of Goerlach-Graw (US Patent No. 5,424,220). Applicants respectfully traverse this rejection. Goerlach-Graw does not remedy the deficiencies of Gibson and Ray, and the rejection should be withdrawn for this reason alone. Applicants do not concede the relevance of Goerlach-Graw to the features of claim 14, or the suitability of the references for combination.

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Conclusion:

Applicants respectfully request favorable reconsideration of this application in the form of a Notice of Allowance. If a telephone conference would be helpful in resolving any issues concerning this communication, please contact Applicants' primary attorney-of record, Douglas P. Mueller (Reg. No. 30,300), at (612) 455-3804.

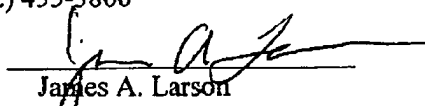


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Respectfully submitted,

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